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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,293	05/31/2001	G. Eric Engstrom	41003.P018	2368

25943 7590 04/09/2004

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EXAMINER
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THEIN, MARIA TERESA T

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 04/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/872,293

Applicant(s)

ENGSTROM, G. ERIC

Examiner

Marissa Thein

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*ML*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Drawings***

The drawings filed on May 31, 2001 are acceptable.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

For example, claim 1 only recites an abstract idea. The recited steps of receiving a subscription from a subscriber and providing the subscriber with a substitute delivery address and receiving a notification to deliver so as to facilitate the delivery of the

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purchased good to the subscriber does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to facilitate the delivery to the subscriber.

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 1 is deemed to be directed to non-statutory subject matter.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-2, 7-16, 19-23, and 26-28 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0013739 to O'Donnell et al.**

Regarding claims 1, 15, and 22, Andrews discloses a delivery address service method, storage medium and an apparatus comprising:

- the receiving by the delivery address service, a subscription from a subscriber, the received subscription including a mailing address of the subscriber (see at least paragraphs 11-12; 26; 92; 108; 125-127; 130; 132);

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- the providing the subscriber with a substitute delivery address (see at least paragraphs 29; 55; 108; 139; 158) ;
- the receiving by the delivery address service a notification of either a request to deliver or an arrival of purchased goods, as a result of the substitute delivery address being used in an online purchaser of the goods (see at least paragraphs 11-12; 26; 37; 87); and
- the intervening by the delivery address service to facilitate delivery of the purchased goods to the subscriber, using the provided mailing address of the subscriber (see at least see at least paragraphs 11-12; 26; 87-88; 92; 108; 125-127; 130; 139).

Regarding claims 2, 16, and 23, O'Donnell discloses the correlation of the substitute delivery address to the mailing address of the subscriber (see at least paragraphs 29; 55; 139).

Regarding claims 7-9, 19-20, and 26-27, O'Donnell discloses wherein the substitute delivery address comprises one of a plurality of virtual delivery address artificially created by the delivery address service (see at least abstract; paragraphs 139; 158); the receiving of a notification of a request to deliver a purchased good from a delivery service, and the providing the mailing address of the subscriber to the delivery deliver service (see at least paragraphs 17; 134-135; 158; 265); and the delivery address service providing the mailing address of the subscriber to the delivery service (see at least paragraphs 265-267).

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carrier, delivery service provider, shipping service provider, and transporter (paragraph 92). The third party shipper can be third party carrier, third party shipping service provider, third party delivery service provider, etc (paragraph 94). Furthermore, O'Donnell discloses tracking information which include name of shipping party and address information, name of receiving party and the address information, etc. (paragraph 202). Yamada, on the other hand, teaches the mailboxes and the mailbox proximately located with the mailing address of subscriber (col. 1, lines 11-15; col. 1, lines 22-44).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method, storage medium for executing instructions, and apparatus of O'Donnell, to include the mailbox the mailbox proximately located with the mailing address of subscriber, as taught by Yamada, so as to provide a place that is most convenient for the customer (col. 6, lines 10-31).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent Application Publication No. 2001/0044785 to Stolfo et al. discloses a method and system for private shipping to anonymous users purchasing goods on a computer or communication network.

U.S. Patent Application Publication No. 2002/0022967 to Ohkado discloses a goods delivery method for improving the anonymity of a customer.

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Regarding claims 10-12, 21, and 28, O'Donnell discloses the receiving a confirmation by the deliver address service of the purchase (see at least paragraph 33; 71; 137; 264); wherein the delivery address service receives the confirmation from the subscriber (see at least paragraph 33; 71; 137; 264); and receives the confirmation from an online business from which the goods to be delivered was purchased (see at least paragraph 33; 71; 137; 264).

Regarding claims 13-14, O'Donnell discloses the subscriber is a purchaser of the goods; or a beneficiary of the purchaser (see at least paragraph 90).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 3-6, 17-18, 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0013739 to O'Donnell et al. in view of U.S. Patent Application No. 6,336,100 to Yamada.**

O'Donnell substantially discloses the claimed invention, however, it does not explicitly disclose the mailboxes and the mailbox proximately located with the mailing address of the subscriber. O'Donnell discloses the method and apparatus for providing anonymous shipping services (paragraph 2). O'Donnell discloses the apparatus includes one or more shipping service provider computer and one or more third party shipping service provider computers (paragraphs 17 and 19). The shipper can be

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U.S. Patent Application Publication No.2003/0208411 to Estes et al. discloses a method and system of manufactures for shipping a package privately to a customer, so that the sender does not learn the recipient's identity.

PCT Publication No. WO 00/14648 to Brenner discloses a method of delivering goods purchased from a vendor website without revealing the customer's identity or physical shipping address to the vendor computer.

PCT Publication No. WO 01/69914 to Andrews et al. discloses a method of managing a transaction on the Internet between a consumer and an e-merchant in which the actual shipping address of the consumer is not provided to the merchant.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 703-305-5246. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Smith can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mtot  
March 29, 2004



Jeffrey A. Smith  
Primary Examiner